



PATENT
Attorney Docket No. 209897
DHHS Reference No. E-103-2000/0-US-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lazarus et al.

Application No. 09/814,558

Filed: March 22, 2001

Art Unit: 1653

Examiner: D. Lukton

For: DMT-TIC DI-AND TRI-PEPTIDIC
DERIVATIVES AND RELATED
COMPOSITIONS AND METHODS OF
USE

#151
JM
5/15/03

DECLARATION UNDER 37 C.F.R. § 1.132

I, Lawrence H. Lazarus, do hereby declare as follows that:

1. I am an inventor of the subject matter disclosed and claimed in the above-identified application.
2. Lazarus et al., *Proceedings of the 3rd International Symposium of Peptide Chemistry and Biology*: 24-29 (1999), lists Lawrence H. Lazarus, Sharon D. Bryant, Peter S. Cooper, Clementia Bianchi, Remo Guerrini, Gianfrano Balboni and Severo Salvadori as co-authors.
3. While Sharon D. Bryant, Peter S. Cooper, Clementia Bianchi, Remo Guerrini and Gianfrano Balboni are identified as co-authors on the aforementioned publication, these individuals worked under the direction and supervision of Severo Salvadori and myself and were cited as co-authors of the Lazarus et al. article in recognition of the work that they performed under our direction and supervision. Sharon D. Bryant, Peter S. Cooper, Clementia Bianchi, Remo Guerrini and Gianfrano Balboni did not, in fact, independently contribute to the conception and reduction to practice of the subject matter described in this

Declaration considered -
-7/16/03 - D. Lukton

In re Appln. of Lazarus et al.
Application No. 09/814,558

article, nor did they independently contribute to the conception and reduction to practice of the invention disclosed and claimed in the above-identified application.

4. I hereby declare that all statements made herein of my own knowledge are true, that all statements made on information and belief are believed to be true, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

FURTHER, DECLARANT SAYETH NOT.

Date: 5 May 03



Lawrence H. Lazarus

REMARKS

The Present Invention

The present invention is directed to compounds comprising the Dmt-Tic pharmacophore, related compositions and methods of use.

The Pending Claims

Claims 1, 2, 9-11 and 15-24 are pending, with claims 11 and 15-18 withdrawn as directed to nonelected subject matter. Claims 1, 19 and 21-23 are directed to compounds, whereas claims 10, 20 and 24 are directed to the compositions comprising such compounds, and claims 11 and 15-18 are directed to methods of use.

The Amendments to the Claims and Abstract

The abstract was amended to conform to standard grammar practices. Claims 2 and 9 have been canceled, and rewritten as claims 22 and 23, respectively. Claims 3-8 and 12-14 also have been canceled. Other claims have been amended to point out more particularly and claim more distinctly the present invention. In particular, claims 1 and 19 have been amended to recite compounds of the present invention, as supported by the specification at, for example, page 5, line 1, through page 6, line 15. Finally, claims 21 and 24 have been added as supported by the specification at, for example, page 5, line 1, through page 6, line 17. No new matter has been added by way of these amendments.

The Office Action

The Office has objected to the abstract on grammatical grounds. Claim 1 has been rejected under 35 U.S.C. § 102(b) as anticipated by Lazarus et al., *Drug Development Today*, 3, 284-294 (1998) ("Lazarus I"). In addition, claims 1 and 19 have been rejected under 35 U.S.C. § 102(a) as anticipated by Lazarus et al., *Proceedings of the 3rd International Symposium of Peptide Chemistry and Biology*, 24-29 (1999) ("Lazarus II"). Reconsideration of the pending claims is hereby requested.

Discussion of the Objection to the Abstract

As suggested by the Examiner, the abstract has been amended to include complete sentences, thereby rendering the Office's objection moot.

In re Appln. of Lazarus et al.
Application No. 09/814,558

Discussion of the Rejections Under 35 U.S.C. § 102

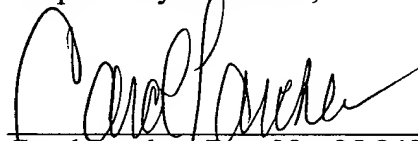
The Office has rejected claim 1 under Section 102(b), as anticipated by Lazarus I. This rejection is believed to be moot in view of the amendment of claim 1.

Claims 1 and 19 have been rejected under Section 102(a), as anticipated by Lazarus II. In view of the submission herewith of a Declaration under 37 C.F.R. § 1.132 by Dr. Lawrence Lazarus, Lazarus II is removed as prior art to the instant application. While this application was filed on March 22, 2001, it claims priority to a provisional application filed on March 24, 2000. The provisional application was filed less than one year after the publication of Lazarus II. Therefore, the rejection under Section 102(a) should be withdrawn.

Conclusion

The application is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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